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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,425	02/01/2001	Lee A. Chase	LII153B US	7026
21133	7590	05/12/2006	EXAMINER	
VAN OPHEM & VANOPHEM, PC REMY J VANOPHEM, PC 51543 VAN DYKE SHELBY TOWNSHIP, MI 48316-4447			STORMER, RUSSELL D	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/775,425	Applicant(s) CHASE ET AL.	
	Examiner Russell D. Stormer	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on March 27, 2006 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rim portion having a "flangeless rim flange" as set forth in claim 42 must be shown or the feature canceled from the claim.

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

Art Unit: 3617

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The amendment filed March 27, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The description of the rim flange having been "machined" as set forth at least on pages 10, 11, 16, 17, 18, 24, and 26.

The rim flange being machined to a "minimum functional" flange height added to at least pages 10 and 16.

The "flangeless rim" or "flangeless wheel" as added to at least pages 11, 12, 17, and 26.

Applicant is required to cancel the new matter in the reply to this Office Action.

Art Unit: 3617

4. The disclosure is objected to because of the following informalities:

The last sentence of paragraph 0014 is objected to because it is *not* logical to presume that the covers of the patents in question can extend radially beyond the peripheral edge of the wheel rim. This statement is not supported in any of the references Applicant has mentioned in the discussion of the prior art, and is actually nothing more than conjecture and Applicants' own opinion. This sentence must be deleted from the disclosure.

Appropriate correction is required.

5. The disclosure is objected to because of the following informalities:

The use of the term "flangeless" to describe certain embodiments of the disclosed wheel rims is objected to as confusing and incorrect. The rims in figures 7-10 are described as being "flangeless" or "modified to be eliminated," but they actually do have rim flanges such as 337, 437, etc. The tire could not be retained on the rim without the flange. In these embodiments, the flange lip has been removed, or the flange has been modified to a different shape.

Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

The specification does not describe how tire changing equipment "cannot damage" the surface of the overlay or how "any form of material handling of said wheel during production and/or transportation of said assembly will prevent said cladding from

Art Unit: 3617

becoming damaged by adjacent assemblies contacting each other” as set forth in claims 29, 42, and 53.

The specification does describe how certain types of equipment are prevented from contacting the overlay, or how the susceptibility to damage is reduced, but there is no disclosure for the overlay never being damaged by any type of equipment or handling ever as appears to be claimed.

See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Claim Objections

7. Claims 29, 42, and 53 are objected to because of the following informalities: The term “webb” should probably be changed to - web- .

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 41, 52, 65, and 66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 3617

The specification does not give any examples of the "industry standard" dimensions for the rim flange, or for the balancing weights as set forth in claims 41, 52, 65, and 66. There are many sizes and types of wheels and rims, and also many types of balance weights. It is not clear what exactly would be encompassed by the "industry standard" rim flanges and the "industry standard" balancing weights."

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 29-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 29, 42, and 53, the phrase "any form of material handling of said wheel during production and/or transportation of said assembly will prevent said cladding from becoming damaged by adjacent assemblies contacting each other" is not understood. It appears that Applicant is claiming that the overlay cannot ever be damaged by any equipment during production or transportation. Such equipment is not described in detail, is not shown in the drawings, and it is not seen how this limitation is possible.

Claim 52 sets forth an "industry standard" rim flange, but depends from claim 42, which purports to have a "flangeless rim flange" so it is therefore indefinite as to how the rim can have a flange and still be flangeless. Note paragraph 0060 of the instant

Art Unit: 3617

specification which states that the so-called "flangeless rim" cannot be considered to be a standard rim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 29, 32, 33, 41, 53, 56, 57, 65, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Beam.

The rim flange shown in figure 5 is considered to be truncated as the axial extension of the flange lip is limited. The diameter of the overlay is less than that of the wheel rim so it would be less susceptible to damage from wheel handling equipment.

With respect to claims 33 and 57, an offset is shown at 44 or 46, both of which would help locate the overlay on the wheel.

With respect to claim 41, a balance weight is shown in figure 4.

14. Claims 29, 32, 33, 34, 53, 56, 57, 58, 65, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase.

Chase (U.S. Patent No. 5597213; hereafter Chase '213) discloses a wheel and overlay assembly comprising an overlay adhesively attached to the wheel and having a diameter less than that of the rim. This would inherently reduce the potential for damage caused by tire-changing equipment. As shown in figure 7, the rim has an outer lip 522

Art Unit: 3617

which is considered to be truncated inasmuch as it is axially shorter than some of the other flange lips shown in the patent, such as the lip 122 shown in figure 3.

The overlay may have an offset 120 as shown in figure 3.

With respect to claims 34 and 58, note that the overlay may be secured to the wheel by a foam adhesive and a silicon adhesive for sealing the assembly as described in column 9, lines 32-43.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 30, 31, 35-40, 54, 55, and 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beam.

Art Unit: 3617

With respect to claims 30, 31, 54, and 5, the tolerances between the edge of the overlay and the outermost edge of the rim flange lip would have been obvious as design expedients because those of ordinary skill in the art could readily determine suitable dimensions for the overlay to produce a desired amount of coverage, and also could determine the tolerance needed or desired to properly cover the wheel rim.

With respect to claims 35-40 and 59-64, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance. Official Notice is hereby given.

18. Claims 30, 31, 35-40, 54, 55, and 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase '213.

With respect to claims 30, 31, 54, and 5, the tolerances between the edge of the overlay and the outermost edge of the rim flange lip would have been obvious as design expedients because those of ordinary skill in the art could readily determine suitable dimensions for the overlay to produce a desired amount of coverage, and also could determine the tolerance needed or desired to properly cover the wheel rim.

With respect to claims 35-40 and 59-64, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance. Official Notice is hereby given.

Art Unit: 3617

19. Claims 42-46 and 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al in view of Eikhoff et al.

Baumgartner et al (U.S. Patent 6068350; hereafter Baumgartner et al) discloses an overlay for a flangeless (lipless rim flange) wheel rim comprising a cover adhesively attached to the wheel as shown in figure 3. Offsets, at 51 or 58, can be used to locate the overlay on the wheel.

With respect to claims 48-51, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance. Official Notice is hereby given.

The outer edge of the overlay at 58 is not described as having a diameter smaller than that of the rim flange at 41.

Eikhoff et al teaches an overlay for a wheel comprising a cover which closely fits over the wheel and may extend beyond the outer diameter of the rim (figure 10) or may have a diameter smaller than that of the rim as shown in figure 11. From this teaching it would have been obvious to size the overlay of Baumgartner et al to have a diameter that was smaller than that of the rim in order to prevent the tire from contacting the overlay during use.

With respect to claim 52, it would have been obvious for the rim to have a standard dimension in order to receive a balancing weight to so that the wheel could be balanced using conventional weights.

Art Unit: 3617

20. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al in view of Eikhoff et al as applied to claim 45 above, and further in view of Chase '213.

To use a foam adhesive and a bead of adhesive along the outer areas of the overlay of Baumgartner et al as modified by Eikhoff et al would have been obvious as taught by Chase '213 in order to retain the overlay with a lighter weight foam adhesive and also to seal the edges of the assembly to keep out water and other materials.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other wheel and overlay assemblies.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/10/06


RUSSELL D. STORMER 5/10/06
PRIMARY EXAMINER